APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,554	08/22/2000	Richard Alan Fiedotin	10160-008-999	9688

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EXAMINER
GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/643,554	FIEDOTIN ET AL.
	Examiner	Art Unit	
	Luke Gilligan	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-25</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-25</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a)☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)	4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5)☐ Notice of Informal Patent Application (PTO-152)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6)☐ Other: .

Claims 1-25 have been examined.

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

2.   Claims 4, 5, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

3.   Claim 4 recites the limitation "said electronic prescription renewal request" in lines 2 and

3. There is insufficient antecedent basis for this limitation in the claim. For Examination

purposes, the term "electronic" will be disregarded because a "prescription renewal request" is

previously referred to in claim 1. Claim 5 contains the same deficiencies as claim 4 through

dependencies and, as such, is rejected for the same reasons as given above.

4.   Claim 16 recites the limitation "said electronic renewal prescription" in lines 1 and 2.

There is insufficient antecedent basis for this limitation in the claim. For Examination purposes,

the term "electronic" will be disregarded because a "renewal prescription" is previously referred

to in claim 1.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud,

U.S. Patent No. 5,845,255 in view of PR Newswire, **nevoca.com Enhances Prescription**

Verification System (hereinafter nevoca).

7.   As per claim 1, Mayaud teaches a method for renewing a prescription for a

pharmaceutical via an electronic network, comprising the steps of: generating a prescription

renewal request for the renewal of a prior prescription (see column 19, lines 48-53 and lines 63-

67); receiving a renewal prescription, in response to said prescription renewal request from a

prescriber (see column 20, lines 50-60); and notifying a dispenser to fill said renewal

prescription (see column 20, lines 5-11 and column 32, lines 23-25). While Mayaud appears to

teach transmission of the renewal request via face-to-face interaction between patient and

prescriber, it is unclear exactly how the patient requests the prescription renewal. Nevoca

teaches a system for electronically communicating prescription renewal requests to doctors as a

result of call-in or walk-in requests (see paragraph 7). It would have been obvious to one of

ordinary skill in the art of prescription management at the time of the invention to include this

feature in the system of Mayaud. One of ordinary skill in the art would have been motivated to

incorporate this feature for the purpose of decreasing time spent processing prescriptions (see

paragraph 2 of nevoca).

8.   As per claim 2, Mayaud in view of nevoca teach the method of claim 1 as described

above. Mayaud further teaches the generating step further comprises creating a prescription

renewal request before the expiration of said prior prescription (see column 20, lines 50-54, it is

assumed by Examiner that at least some embodiments of Mayaud would consist of this step

occurring prior to the expiration of the selected prescription).

9.   As per claim 3, Mayaud in view of nevoca teach the method of claim 1 as described above. Mayaud further teaches the generating step further comprises creating said prescription renewal request from the following: a patient identifier, a pharmaceutical identifier, a dispenser identifier, a prescription identifier, a prescriber identifier, a dosage, number of refills, and a strength (see Figure 3).

10.   As per claim 4, Mayaud in view of nevoca teach the method of claim 1 as described above. Mayaud further teaches prior to said receiving step, providing information useful to said prescriber for reviewing said prescription renewal request (see column 20, lines 32-40).

11.   As per claim 5, Mayaud in view of nevoca teach the method of claim 4 as described above. Mayaud further teaches said information is selected from the following: warnings for any drug-drug reactions, formulary listings, patient medication history, and low cost therapeutic alternatives (see column 20, lines 20-40 and column 21, liens 34-51).

12.   As per claim 6, Mayaud in view of nevoca teach the method of claim 1 as described above. Mayaud further teaches said receiving step further comprises the step of acquiring a renewal prescription, wherein said renewal prescription has components that have been changed from said prior prescription (see column 20, lines 50-56, note that the renewal takes place "after editing").

13.   As per claim 7, Mayaud in view of nevoca teach the method of claim 6 as described above. Mayaud further teaches said components are selected from the following: a patient identifier, a pharmaceutical identifier, a dispenser identifier, a prescription identifier, a prescriber identifier, a dosage, number of refills, and a strength (column 20, lines 50-56 and Figure 3).

14.   As per claim 8, Mayaud in view of nevoca teach the method of claim 1 as described above. Mayaud further teaches said receiving step further comprises the step of acquiring an

appeal from said prescriber for a patient of said prior prescription to contact said prescriber (see column 23, lines 29-39).

15.   As per claim 9, Mayaud in view of nevoca teach the method of claim 8 as described above. Mayaud further teaches said acquiring step further comprises notifying said dispenser to inform said patient to contact said prescriber (column 23, lines 29-39).

16.   As per claim 10, Mayaud in view of nevoca teach the method of claim 8 as described above. Mayaud further teaches said acquiring step further comprises notifying said patient to contact said prescriber (see column 23, lines 29-39).

17.   As per claim 11, Mayaud in view of nevoca teach the method of claim 1 as described above. Mayaud further teaches the steps of claim 1 occur for a plurality of prescription renewal requests and renewal prescriptions (see column 20, lines 50-60).

18.   As per claim 12, Mayaud in view of nevoca teach the method of claim 1 as described above. Mayaud does not explicitly teach ascertaining a status of said prescription renewal request. Nevoca teaches ascertaining a status of said prescription renewal request (see paragraph 9). It would have been obvious to one of ordinary skill in the art of prescription management at the time of the invention to include this feature in the system of Mayaud. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of decreasing time spent processing prescriptions (see paragraph 2 of nevoca).

19.   As per claim 13, Mayaud in view of nevoca teach the method of claim 12 as described above. Mayaud does not explicitly teach determining how many prescription renewal requests were transmitted to said prescriber and establishing how many prescription renewal requests said prescriber has addressed. Nevoca teaches these determining and establishing steps (see paragraph 9, the Examiner asserts that these steps would be necessary to determining the "exact status" when a doctor has not yet responded to a prescription renewal request). It would have

been obvious to one of ordinary skill in the art of prescription management at the time of the

invention to include this feature in the system of Mayaud for the reasons given above with

respect to claim 12.

20.   As per claim 14, Mayaud in view of nevoca teach the method of claim 12 as described

above. Mayaud does not explicitly teach sending the status to said prescriber. Nevoca teaches

said ascertaining step further comprises the step of sending said status to said prescriber (see

paragraphs 4 and 9).

21.   As per claim 15, Mayaud in view of nevoca teach the method of claim 1 as described

above. Mayaud further teaches deleting said electronic prescription renewal request after a set

time (see column 15, lines 41-47).

23.   As per claim 16, Mayaud in view of nevoca teach the method of claim 1 as described

above. Mayaud further teaches deleting said renewal prescription after a set of time (see

column 15, lines 41-47).

24.   As per claim 17, Mayaud in view of nevoca teach the method of claim 1 as described

above. Mayaud further teaches accepting said prescription renewal request using a portable

computing device (see column see column 7, lines 57-67); displaying said prescription renewal

request, via said portable computing device, to said prescriber (see column 7, lines 57-67);

showing said prescriber information, via said portable computing device, useful for reviewing

said prescription renewal request (see column 7, lines 57-67 and Figure 3); and communicating

said renewal request to using said portable computing device (see column 7, lines 57-67 and

Figure 3, in particular, reference 80). Mayaud does not explicitly teach electronic transmission

of a request via a server as described above with respect to claim 1. Nevoca teaches a system

for electronically communicating prescription renewal requests to doctors as a result of call-in or

walk-in requests (see paragraphs 4 and 7, note that communication is done on-line through

nevoca.com and, as such, requires a host server). It would have been obvious to one of

ordinary skill in the art of prescription management at the time of the invention to include this

feature in the system of Mayaud. One of ordinary skill in the art would have been motivated to

incorporate this feature for the purpose of decreasing time spent processing prescriptions (see

paragraph 2 of nevoca).

25.   As per claim 18, Mayaud in view of nevoca teach the method of claim 1 as described

above. Mayaud further teaches receiving said prior prescription (see column 20, lines 50-51);

determining whether a prescribed pharmaceutical from said prior prescription is on formulary

(see column 32, lines 7-13); and dispensing said prescribed pharmaceutical based on said

determining step (see column 32, lines 23-25).

26.   As per claim 19, Mayaud in view of nevoca teach the mthod of claim 18 as described

above. Mayaud further teaches ascertaining whether said prescribed pharmaceutical is a

chronic medication (see column 20, lines 41-49 and Figure 3, the patient history would indicate

if a prescription had been prescribed for a chronic illness); and storing a result of said

ascertaining step (see column 20, lines 41-49 and Figure 3, this result is at least temporarily

stored in the memory of the portable computing device).

27.   As per claim 20, Mayaud in view of nevoca teach the method of claim 1 as described

above. Mayaud further teaches the initial step of determining whether refills are available for

said prior prescription (see Figure 3, reference 100).

28.   As per claim 21, Mayaud in view of nevoca teach the method of claim 1 as described

above. Mayaud further teaches obtaining a patient record, said record containing at least a

patient identifier, a pharmaceutical identifier for a currently prescribed pharmaceutical, a number

of authorized refills of the currently prescribed pharmaceutical, and a date of the last filling of the

currently prescribed pharmaceutical (see Figure 3); and setting a renewal date before a last refill

has been consumed by a patient if said number of authorized refills is greater or equal to a predetermined number (see column 26, lines 57-60).

29.   Claims 22 and 23 contain substantially similar limitations to claims 5 and 17 and, as such, are rejected for similar reasons as given above.

30.   Claims 24 and 25 contain substantially similar limitations to claims 1 and 17 and, as such, are rejected for similar reasons as given above.

Conclusion

31.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Reber et al. teach a system for renewing prescriptions based on communications generated from medicine containers.

- Kobylevsky et al. teach an automated remote prescription refilling system.

- Parks discusses several online electronic prescription services.

- Ukens discloses online prescription renewals.

32.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (703) 308-6104. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

33.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

34.   Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

CLG

9/5/03

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